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JUN 29 2004

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June 29, 2004

VIA FACSIMILE

(Total No. of Pages Transmitted: 5)

To: Examiner Congvan Tran
Group Art Unit: 2683
U.S.P.T.O.

Facsimile No.: 703-872-9306

From: John J. Dresch, Esq.

Facsimile No.: (703) 761-2375 or 76


Re: Enclosed Petition to Withdraw Finality
U.S. Patent Application No.: 09/866,714
Attorney Docket No.: 2000P163824
Our Reference: FUK.011

Dear Examiner Tran:

Further to my telephonic voice messages, enclosed for your consideration is a timely filed Petition to Withdraw Finality under 37 C.F.R. § 1.181 of the Office Action dated April 29, 2004, in the above-referenced application.

Thank you in advance for your kind consideration on this case.

Very truly yours,


John J. Dresch, Esq.
Registration No. 46,672

JJD/SMM
Enclosure (Petition to Withdraw Finality - 4 pages)

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FUK.011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Kiyoshi Tamukai

Serial No.: 09/866,714

Group Art Unit: 2683

Filed: May 30, 2001

Examiner: Tran, Congvan

For: PORTABLE TELEPHONE SET AND COMMUNICATIVE BASE STATION
SWITCHING SYSTEMHonorable Commissioner of Patents
Alexandria, VA 22313-1450**PETITION TO WITHDRAW FINALITY OF REJECTION AS PREMATURE UNDER 37
C.F.R. § 1.181**

Sir:

Applicant respectfully petitions under 37 C.F.R. § 1.181 that the finality of Patent Application S/N 09/866,714: "PORTABLE TELEPHONE SET AND COMMUNICATIVE BASE STATION SWITCHING SYSTEM" be withdrawn as premature under the guidelines of M.P.E.P. § 706.07(a). This guideline states: "...second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims..." (emphasis added).

Applicant respectfully submits that, contrary to the Examiner's position in the latest Office Action dated April 29, 2004, one of ordinary skill in the art would readily recognize that the claim amendments in the Amendment Under 37 C.F.R. § 1.111 filed on February 23, 2004, were not all directed to the purpose of overcoming the rejection of the Office Action dated November 26, 2003. Applicant respectfully submits that no claim amendments were necessary

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(FUK.011)

to overcome the rejection of at least independent claim 6, and that the amendments were clearly not so intended.

In the Office Action dated April 29, 2004, the Examiner has withdrawn the previous rejection of independent claim 6 based on U.S. Patent No. 6,496,493 to Chung and has raised a new ground of rejection based on newly cited prior art U.S. Patent No. 6,327,471 to Song. Applicant respectfully submits that the new ground of rejection was not necessitated by Applicant's amendment filed on February 23, 2004.

Particularly, in the Office Action dated April 29, 2004, the Examiner alleges that the new ground of rejection was necessitated by Applicant's amendments, and therefore, made this rejection final.

Applicant submits, however, that independent claim 6 was not amended in the Amendment filed on February 23, 2004, and therefore, the finality of the present Office Action clearly is premature.

That is, independent claim 6 has been rejected based on a new ground of rejection which clearly was not necessitated by Applicant's amendment (since independent claim 6 was not amended).

For at least the foregoing reasons, Applicant respectfully submits that the new ground of rejection of independent claim 6 was not necessitated by Applicant's amendment, and therefore, the finality of the Office Action dated April 29, 2004 is premature.

Moreover, Applicant submits that independent claim 7 was amended merely to obviate informalities, and also should not have necessitated the new ground of rejection. Indeed, while claim 7 was amended in the Amendment filed on February 23, 2004, the amendments merely were editorial in nature and should not have changed the scope of these claims.

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In the Office Action dated April 29, 2004, the Examiner has withdrawn the previous rejections of claim 7 and has raised a new ground of rejection based on newly cited prior art. Applicant respectfully submits that the new ground of rejection of independent claim 7 also was not necessitated by Applicant's amendment filed on February 23, 2004.

Thus, for the foregoing reasons, Applicant respectfully submits that the traversal arguments submitted with the Amendment filed on February 23, 2004, were successful in overcoming the rejection of independent claim 6 under 35 U.S.C. § 102(e) as being anticipated by Chung (U.S. Patent No. 6,496,493) and the rejection of independent claim 7 under 35 U.S.C. § 102(b) as being anticipated by Israelsson (U.S. Patent No. 5,293,643). These rejections were not maintained in the Office Action dated April 29, 2004, and thus, have been withdrawn.

For at least the reasons outlined above, Applicant respectfully petitions that the finality of the rejections for the above-identified Application be withdrawn.

Respectfully Submitted,

Date: JUNE 29, 2004


John J. Dresch, Esq.
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Sean M. McGinn, Esq.
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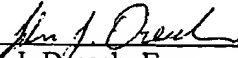
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(FUK.011)

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CERTIFICATE OF TRANSMISSION

I certify that I transmitted via facsimile to (703) 872-9306 the enclosed Petition to Withdraw Finality under 37 C.F.R. § 1.181 to Examiner Congvan Tran, on June 29, 2004.


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